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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,892	08/29/2001	Eric D. Anderson	500247.03	2384

7590

07/01/2005

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EXAMINER

ENGLAND, DAVID E.

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/943,892

Applicant(s)

ANDERSON, ERIC D.

Examiner

David E. England

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 30-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>04/12/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 30 – 36 are presented for examination.

#### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 30 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This limitation of, “if the Email communication notification distinct from the Email communication,” is not found in the specification. In fact, the specification suggest that at least one recipient can have the Email communication stored on a server and has no bearing on “if” there are a “plurality of recipients”, (e.g. page 5, lines 10 – 16, “*In particular, the Message Distribution Server (MDS) system receives electronic messages to be distributed to one or more recipients, centrally stores a single copy of the message as well as various information about sending the message...*”).

#### *Claim Rejections - 35 USC § 103*

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 30, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561) in view of Aronson et al. (6654787) (hereinafter Aronson).

6. Referencing claim 30, as closely interpreted by the Examiner, Dillon teaches a computer-implemented method for one of a plurality of designated recipients of an Email communication to receive the Email, comprising:

7. receiving on a recipient's computer an Email communication notification from the server that references the single copy of the Email communication, the Email communication notification distinct from the Email communication, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, line 12 – 65);

8. requesting from the server the referenced Email communication, the request being sent to the Email communication program from the recipient's computer system, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, line 12 – 65), but does not specifically teach providing an Email communication program on a server that is configured with instructions to store a single copy of the Email communication on the server if the Email communication is designated for the plurality of recipients;

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9. receiving by the recipient's computer system from the server, a copy of the requested Email communication.

10. Aronson teaches providing an Email communication program on a server that is configured with instructions to store a single copy of the Email communication on the server if the Email communication is designated for the plurality of recipients, (e.g. col. 10, line 65 – col. 11, line 6);

11. receiving by the recipient's computer system from the server, a copy of the requested Email communication, (e.g. col. 8, line 30 – col. 9, line 16). It would have been obvious to one skilled in the art at the time the invention was made to combine Aronson with Dillon because it would be more efficient to conserve space with having one central location, having users reference the single copy of the email then having multiple copies of an email taking up substantial space. Furthermore, it is more convenient for a user to have a local copy of an Email so incase the user is off line and wants to modify the local copy of the Email, the user could without modifying the original Email that could be used as an archived document for reference if desired.

12. As per claim 34, as closely interpreted by the Examiner, Dillon teaches the Email communication received from the server is encrypted using a public encryption key for the one of the plurality of designated recipients, and including retrieving a private encryption key for the one of the plurality of designated recipients to decrypt the Email communication, (e.g. col. 9, line 60 – col. 10, line 15).

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13. As per claim 35, as closely interpreted by the Examiner, Dillon and Aronson teach all that is similar in nature to claims 30 and 34, more specifically, Dillon teaches the acts of receiving the notification, requesting the Email communication and receiving the Email communication are performed by a receiving computer lacking sufficient permanent storage to store the Email communication, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, line 12 – 65).

14. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561) in view of Aronson (6654787) in further view of Arnold (6275848).

15. Referencing claim 31, as closely interpreted by the Examiner, Dillon and Aronson do not specifically teach when access to the Email communication is no longer desired by the recipient, indicating to the Email communication program to delete the Email communication, so that the Email communication program deletes the single stored copy of the Email communication from the server after receiving indications from all recipients to delete the Email communication. Arnold teaches when access to the Email communication is no longer desired by the recipient, indicating to the Email communication program to delete the Email communication, so that the Email communication program deletes the single stored copy of the Email communication from the server after receiving indications from all recipients to delete the Email communication, (e.g. col. 4, line 25 – col. 5, line 25). It would have been obvious to one skilled in the art at the time the invention was made to combine Arnold with the combine system of Dillon and Aronson because of similar reasons stated above.

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16. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561) in view of Aronson (6654787) in further view of Arnold (6275848) with what is well known in the art.

17. As per claim 33, Dillon does not specifically teach storing the Email communication locally by the recipient on the recipient's computer system such that the local stored Email communication is preserved even when the Email communication program deletes the single stored copy of the Email communication from the server.

18. Official Notice is taken that it was a common practice to store the Email communication locally by the recipient on the recipient's computer system such that the local stored Email communication is preserved even when the Email communication program deletes the single stored copy of the Email communication from the server at the time the instant invention was made.

19. It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method disclosed by Dillon because of similar reasons stated above. Furthermore, if the user saves the Email locally on one computer and disconnects from the network and then logs in on a different computer and deletes the Email on the server there is no way for the Email to be deleted on the first computer. Also if the user were to save the Email on a floppy disk and then delete the Email from the server, the server cannot delete the Email on the floppy disk, especially if the floppy disk is removed.

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20. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561) in view of Aronson (6654787) in further view of Arnold (6275848) in further view of Devine et al. (6385644) (hereinafter Devine).

21. As per claim 32, as closely interpreted by the Examiner, Dillon, Aronson and Arnold do not specifically teach after the receiving of the Email communication notification, storing the Email communication notification locally on the recipients computer system;

22. after the indicating to the Email communication program to delete the Email communication, deleting the stored Email communication notification by the Email communication program, even if all recipients have not indicated to the Email communication program to delete the Email communication. Devine teaches after the receiving of the Email communication notification, storing the Email communication notification locally on the recipients computer system, (e.g. col. 12, lines 40 – 55);

23. after the indicating to the Email communication program to delete the Email communication, deleting the stored Email communication notification by the Email communication program, even if all recipients have not indicated to the Email communication program to delete the Email communication, (e.g. col. 12, lines 40 – 55). It would have been obvious to one skilled in the art at the time the invention was made to combine Devine with the combine system of Dillon, Aronson and Arnold because of similar reasons stated above and further, if a user has a personal records of Email communication notifications it could prevent loss of information if the server were to break down and/or crash, (i.e. redundancy).



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24. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561) in view of Aronson (6654787) in further view of Homan et al. (6317485).

25. Referencing claim 36, as closely interpreted by the Examiner, Dillon and Aronson do not specifically teach wherein contents of the received Email communication notification are based on preferences for the one of the plurality of designated recipients, the preferences previously supplied to the server configured with the Email communication program. Homan teaches wherein contents of the received Email communication notification are based on preferences for the one of the plurality of designated recipients, the preferences previously supplied to the server configured with the Email communication program, (e.g. col. 6, lines 28 – 49 & col. 7, lines 1 – 44). It would have been obvious to one skilled in the art at the time the invention was made to combine Homan with the combine system of Dillon and Aronson because of similar reasons stated above and further it would be more efficient for a system to utilize a type of preference setting to classify or possibly utilize different types of Email communication notifications. This will diversify the way a user may receive notifications about incoming Email.

### *Response to Arguments*

26. Applicant's arguments filed 12/29/2004 have been fully considered but they are not persuasive.

27.

28. In the Remarks, Applicant argues in substance that Examiner has improperly convoluted the distinction between the 112, first paragraph, "written description" requirement and the

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“enablement requirement.” There is no assertion by the Examiner that one of ordinary skill in the art is not able to make and use the claimed invention without undue experimentation based on the specification. Moreover, with respect to software, which is the field for the best mode for implementing the present invention, the Federal Circuit has held that “[a]s a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure the function of the software. This is because, normally, writing code for such software is within the skill of the art, not required undue experimentation, once its functions have been disclosed.

29. As to part 1, Examiner disagrees with the Applicant’s assumption on the improper 112, first paragraph rejection. The intent of the Examiner was to point to section of the application that would leave one of ordinary skill in the art to believe that the claim language of the Applicant’s invention could not be done without undue experimentation because of what is taught in the specification verses what is actually claimed. Although these rejections could be placed under 112, first paragraph regarding “written description”, the format of the rejections and descriptions written by the Examiner were designed to provoke the Applicant to confirm or deny the steps in the specification, in correlation with the Figures, by pointing to and discussing the correct sections, whether it being the ones pointed out by the Examiner or not, that could enable a person skilled in the art to make and use the claimed invention without undue experimentation because of the misleading language of the claimed invention.

30. Applicant as also stated that, “Applicant will accordingly proceed to address the rejection under section 112, presuming that the Examiner intended to draw the rejections under the written description requirement rather than the enablement requirement of 112, first paragraph.

31. Therefore, the Examiner will attempt to respond to the Remarks with the intention of “enablement” while discussing points that could be made about the Applicant’s “written description”.

32. In the Remarks, Applicant argues in substance that there is implicit and explicit support for this limitation in specification as a whole and in the original filed claims for the limitation of “if it is determined that multiple recipients have been indicated, storing a single copy of the Email communication on the server.”

33. Applicant points to the Background section, which they say makes it clear that the context of the invention is for when multiple recipients are designated. For example to contrast with the problems of the prior art, at page 1, line 16 of the Applicant’s application which stated, “For example, when an electronic message is to be sent to multiple recipients, current messaging systems deliver a separate copy of the message from the sender’s system to each of the recipients’ system... Each recipients system that receive the message is then responsible for storing and managing the message.” By implication, the claimed method, which solves the problem by storing a single copy of the message, is used in cases when multiple recipients are designated.

34. As to part 2, Applicant points out subject matter that is in the background of the invention, which is well known in the art. The Applicant does not point to any section of the specification that is not prior art and is unique from the Applicant’s invention. The claim language and the specification still do not enable one of ordinary skill in the art to make or use the claim limitation without undue experimentation, nor has the Applicant pointed to any

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sections of the Figures that would aid in the process of enabling the novelty in the Applicant's invention, more specifically a conditional item in a figure that would suggest an "if, then, else" type Boolean function, *In re Donohue*, 550 F.2d 1269, 1271, 193 USPQ 136, 137 (CCPA 1977) ("Employment of block diagrams and descriptions of their functions is not fatal under 35 U.S.C. 112, first paragraph, providing the represented structure is conventional and can be determined without undue experimentation."). For the possibility of a 112, first paragraph rejection under "written description", the Applicant has not disclosed any teachings or pointed to any sections in the specification, that is not prior art, or drawing that would prove the or disprove the Examiner interpretation.

35. In the Remarks, Applicant argues in substance that Dillon is totally silent about whether a single copy of the email communication is stored when there are multiple recipients designated.

36. As to part 3, Examiner would like to draw the Applicant's attention to the rejection stated above. In which, it is clear that Dillon is not relied upon for storing a single copy of the email when there are multiple recipients designated. Therefore argument is moot.

37. In the Remarks, Applicant argues in substance that Aronson teaches providing and Email communication program on a server that is configured with instructions to store a single copy of the Email communication on the server if the Email communication is designated for the plurality of recipients. Furthermore, the cited text teaches nothing whether or not a plurality of users have been indicated, let alone whether a single copy of the email communication is stored based on that criteria. Moreover, the motivation provided by the Examiner to combine Dillon and

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Aronson is an embodiment of the Applicant's invention and found nowhere in the references of Dillon and Aronson.

38. As to part 4, Examiner would like to draw the Applicant's attention to another area of Aronson which teaches that a filter is used to gather messages that could be spam, (e.g., col. 5, lines 20 – 67). The criteria can be based upon multiple combination such as word or letter frequency analysis and (6) feature extraction & analysis (e.g., based on phone numbers, URL's, addresses). This in combination with column 10, line 65 to column 11, line 6, would leave one to believe that the system can store a single copy of a message based on multiple criteria.

Therefore, prior art reads on Applicant's claim language. Furthermore, when reviewing a reference the applicants should remember that not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. In re Preda, 401 F. 2d 825, 159 USPQ 342 (CCPA 1968) and In re Shepard, 319 F. 2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. In re Sovish, 769 F. 2d 738, 226 USPQ 771 (Fed. Cir. 1985). Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. In re Jacoby, 309 F. 2d 513, 135 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F. 2d 656, 193 USPQ 12 (CCPA 1977).

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39. As to the motivation, Examiner would like to point to the section cited above, col. 10, line 65 – col. 11, line 6, in which it is stated, “*This technique of caching only one copy of a spam message in spam storage module 340 allows proxy server 300 to conserve significant space in spam storage area 340 given the fact that spam is commonly distributed to thousands of e-mail users at a time.*” Therefore, motivation is present.

40. In the Remarks, Applicant argues in substance that the Examiner has not properly characterized Arnold, which was said to teach “when access to the Email communication is no longer desired by the recipient, indicating to the server to delete the Email communication, so that the server deletes the single stored copy of the Email communication after receiving indications from all recipients to delete the Email communication. The cited text does not refer to deleting the email message *per se*, but rather to deleting the attachment that has been detached from the original Email message.

41. As to part 5, Examiner would like to state that if an email only consists of an attachment and only one copy was stored on a central, then Arnold would read on the claim language of deleting a single stored copy of the email communication after receiving indications from all recipients to delete the email communication. Furthermore, it would only take one of ordinary skill in the art to apply this technique to specific emails as it is applied to attachments.

42. In the Remarks, Applicant argues in substance that Applicant admits that it is well known in the art to locally store an email communication. What was not known in the art, however, was

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to provide an email communication that performs the other functions of Applicant's system as described above.

43. As to part 6, since Examiner has proven that all the elements of the Applicant's claim language is taught then the Official Notice still stands in the rejection as stated above.

44. In the Remarks, Applicant argues in substance that Applicant would accept that the Inbox functionality described by Devine may be construed as a repository for locally storing emails. However, the Examiner has also cited this same text as teaching "deleting the stored Email communication notification even if all recipients have not indicated to delete Email communication."

45. As to part 7, Examiner would like to point out that the limitation above makes one interpret that the locally stored email communication notification has no bearing on what occurs on the server side of the system, i.e., the locally stored notification is independent and is not controlled by the server. This could also mean that a user could disconnect their computer from the network and delete was is locally stored without anything happening to the server side. This is apparent in parts of Dillon, Aronson and Arnold teachings above as to storing holding and deleting email communication and notifications. also can be applied to this argument which has similar remarks. In combination with Devine, the prior art teaches the claimed invention and the limitation of deleting the stored email communication notification

46. In the Remarks, Applicant argues in substance that Homan also fails to cure the deficiency of the primary references with regard to conditional storage of the Email

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communication as a single copy on a server based on whether a plurality of recipients have been indicated.

47. As to part 8, Examiner would like to draw the Applicant's attention to the above responses to arguments for this Remark as been addressed above as to which pieces of prior art teach the specific areas of the Applicant's claim language.

### *Conclusion*

48. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 571-272-3912. The examiner can normally be reached on Mon-Thur, 7:00-5:00.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David E. England  
Examiner  
Art Unit 2143

De



DAVID WILEY  
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